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JUL 30 2007

### REMARKS

The Final Office Action dated April 30, 2007 contained a final rejection of claims 1-19, 21, 24-30, 32 and 35-37. The Applicant has amended independent claims 1, 10, 13, 27, 36 and 37. Claims 20, 22, 23 and 31, 33 and 34 were canceled in a previous amendment. Claims 1-19, 21, 24-30, 32 and 35-37 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114.

Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-19, 21, 23-30, 32 and 35-37 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, in a first part of the rejection, the Examiner alleged that the Applicants claimed language "...using heuristic data to determine if the candidate advertisements have already been sent to the subscriber and if additional deliveries of the same.." was not supported by the original specification. In a second part of the rejection, the Examiner stated that "...auctioning the resized candidate advertisements to advertisers and auctioning the resized dynamic content to content providers by receiving at least first and second respective offers..." was not supported by the original specification.

The Applicant respectfully traverses this rejection based on the arguments below.

First, regarding the first part of the rejection, although the Applicant submits that the claim language is supported, the Applicant has amended the claim for clarification purposes to state "...using heuristic data to determine if any of the candidate advertisements have already been sent to the subscriber and if additional deliveries another delivery of the same...."

Next, regarding the second part of the rejection, the Applicant respectfully disagrees with the Examiner and submits that the original specification completely supports the rejected language. For instance, the original specification states on page 6 at lines 28-29 that "...the content information files and candidate advertising ***might be suitably resized in auctioning ads*** as described herein to further maximize advertising revenue." [***emphasis added***]. Further, the original specification states on page 6 at lines 31-32 that "***Re-sizing ads and content might done at any conveniently located step.***"

[**emphasis added**]. Therefore, since the original specification unquestionably teaches that re-sized advertisements are in auctioning advertisements and can be done at any step, the claimed language of "auctioning the resized candidate advertisements to advertisers and auctioning the resized dynamic content to content providers" is clearly supported.

In addition, according to Stahelin v. Seher, 24 USPQ2d, 1513 (B.P.A.I. 1992), "[I]t has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement... How such a teaching is set forth, whether by use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims *must* be taken as complying with the first paragraph of 35 USC 112 *unless* there is a reason to doubt the objective truth of the statements relied upon there for enabling support." *Id.* At 1516 (citing In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (C.C.P.A. 1971)) (emphasis in original).

The Applicant submits that the original specification does not contain any reason to doubt the Figures or description for the claimed elements of "...auctioning the resized candidate advertisements to advertisers and auctioning the resized dynamic content to content providers by receiving at least first and second respective offers..." because, as argued above, the original specification states that "...the content information files and candidate advertising might be suitably resized in auctioning ads..." and that "Re-sizing ads and content might done at any conveniently located step," which would enable one of ordinary skill in the art to make or use the invention without undue experimentation. The Examiner can only reasonably doubt an invention's asserted utility if the written description "suggests an inherently unbelievable undertaking or involves implausible scientific principles," which is clearly not the case here. In re Cortright, 49 USPQ 2d 1464, 1466 (Fed. Cir. 1999).

The Federal Circuit has clearly stated that patent applications should be written for persons familiar with the relevant field; the patentee is not required to include in the specification specific programming code as long as the concept is readily understood by practitioners. Otherwise, every patent would be written as a comprehensive tutorial and treatise for the generalist, instead of a concise statement for persons in the field. Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1053-54 (Fed. Cir. 2002).

For example, the court in Enzo Biochem, Inc. v. Calgene, Inc., 52 USPQ 2d 1129, 1135-36 (Fed. Cir. 1999) concluded that a patent specification complies with the statute even if a "reasonable" amount of routine experimentation is required in order to practice a claimed invention, as long as the experimentation is not undue. As such, the description in the specification provides enough enabling support for the claimed "auctioning the resized candidate advertisements to advertisers and auctioning the resized dynamic content to content providers by receiving at least first and second respective offers." Thus, for the reasons as set forth above, the Applicant submits that the rejection should be withdrawn because the claims are enabling and comply with 35 U.S.C. § 112, first paragraph.

The Office Action rejected claims 1-19, 21, 23-30, 32 and 35-37 under 35 U.S.C. 112, second paragraph, as allegedly lacking proper antecedent basis.

The Applicant has amended the appropriate claims as suggested by the Examiner to overcome this rejection.

The Office Action rejected claims 1-19, 21, 24-30, 32 and 35-37 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hanson et al. (U.S. Patent No. 5,974,398) in view of Markowitz et al. (U.S. Patent No. 6,311,185).

The Applicant respectfully traverses this rejection based on the amendments to the claims and the arguments below.

The independent claims (claims 1, 10, 13, 27, 36 and 37) now include using advertising placement offers in the first and second offers that include terms specifying an amount based upon specific placement location in the publication, using specified minimum amounts in the first and second offers for advertisements placed in predetermined areas or locations of the publication and using monetary and non-monetary terms in the first and second offers. Support for these amendments can be found on page 4 (lines 4-13) and FIG. 1 of the original specification.

Specifically, on page 4 at lines 4-13, the original specification states the "...actual location of the ad's placement in the publication – and therefore the value to a prospective advertiser - will vary according to a variety of factors, including, but not limited to the content information (files) that will comprise the rest of the publication at delivery time. ***Advertising placement offers might also therefore include terms***

***that specify an amount based upon placement location in the publication.***

Similarly, an advertiser might require certain ***minimum amounts for ads placed in certain areas or locations of the publication.*** Advertising offers – ***including both monetary and non-monetary terms***, both of which are considered herein and for claim construction to be offer “amounts” and/or offer “prices” – are evaluated at step 120.” ***[emphasis added]***.

According to case law and the MPEP, all of the claimed elements of an Appellant's invention **must be considered**. (*In re Kotzab*, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000). *MPEP 2143*). If **one** of the elements of the Appellant's invention is **missing** from or not taught in the cited references and the Appellant's invention has advantages not appreciated by the cited references, then no prima facie case of obviousness exists. (*MPEP 2143.03*). The Federal Circuit Court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Clearly, the combined references are missing the newly added features of the claims. Namely, the combined cited references merely disclose modifying a web page by adding an advertisement (see Abstract, Summary, FIG. 3 and cols. 3 and 4 of Markowitz et al.) and an advertisement bidding system that allows advertisers to display their paid ads, which when viewed by a user, pays for a portion of the user's service or usage charge (see Abstract, FIGS. 13-15, col. 9, line 29 to col. 11, line 5 of Hanson).

In contrast, the Applicant's claimed invention includes **using advertising placement offers** in the first and second offers that include terms **specifying an amount based upon specific placement location** in the publication, using **specified minimum amounts** in the first and second offers for **advertisements placed in predetermined areas** or locations of the publication and **using monetary and non-monetary** terms in the first and second offers. These newly added features are **not** disclosed, taught or suggested in the combined cited references.

In addition, as argued in a previous amendment, the combined references are also missing the Applicant's claimed **using heuristic data** to determine if any of the candidate advertisements have already been sent to the subscriber and if another

delivery of the same, related or similar advertisements are appropriate according to advertiser demands, expectations, payment and the subscriber's demographic data and automatically resizing the candidate advertisements and the dynamic content, auctioning the resized candidate advertisements and the resized dynamic content by receiving offers and placing on the page of the on-line publication candidate advertisements corresponding to the greatest offer of the auction of the resized advertisements and content.

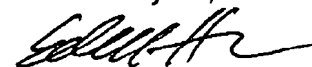
Thus, since the combined references are missing at least one feature of the Applicant's claimed invention, they cannot render the claims obvious. As such, a prima facie case of obviousness cannot be established, and hence, the rejections must be withdrawn. In Re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143).

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). Also, the other references cited by the Examiner also have been considered by the Applicants in requesting allowance of the dependant claims and none have been found to teach or suggest the Applicants' claimed invention.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicant kindly invites the Examiner to telephone the Applicant's attorney at (818) 885-1575 if the Examiner has any questions or concerns. Please note that all correspondence should continue to be directed to:

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